



PTO/SB/21 (01-08)

Approved for use through 07/31/2008. OMB 0651-0031  
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**TRANSMITTAL  
FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

7

Application Number

10/580,485

Filing Date

May 24, 2006

First Named Inventor

Joachim Moormann

Art Unit

1615

Examiner Name

Jeffrey T. Palenik

Attorney Docket Number

RO4246US (#90568)

**ENCLOSURES (Check all that apply)**

Fee Transmittal Form



Fee Attached



Amendment/Reply



After Final



Affidavits/declaration(s)



Extension of Time Request



Express Abandonment Request



Information Disclosure Statement



Certified Copy of Priority Document(s)

Reply to Missing Parts/  
Incomplete ApplicationReply to Missing Parts  
under 37 CFR 1.52 or 1.53

Drawing(s)



Licensing-related Papers



Petition

Petition to Convert to a  
Provisional Application

Power of Attorney, Revocation



Change of Correspondence Address



Terminal Disclaimer



Request for Refund



CD, Number of CD(s) \_\_\_\_\_

☐ Landscape Table on CD

After Allowance Communication to TC

Appeal Communication to Board  
of Appeals and InterferencesAppeal Communication to TC  
(Appeal Notice, Brief, Reply Brief)

Proprietary Information



Status Letter

Other Enclosure(s) (please identify  
below):

return postcard receipt

Remarks

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm Name

D. Peter Hochberg Co., L.P.A.

Signature

Printed name

D. Peter Hochberg

Date

July 21, 2008

Reg. No.

24,603

**CERTIFICATE OF TRANSMISSION/MAILING**

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Typed or printed name

Sean Mellino

Date

7/21/08

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JUL 23 2008

PTO/SB/17 (10-07)

Approved for use through 06/30/2010. OMB 0651-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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Effective on 12/08/2004.

Pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

**FEE TRANSMITTAL**  
**For FY 2008**☒ Applicant claims small entity status. See 37 CFR 1.27TOTAL AMOUNT OF PAYMENT (\$)  
0.00**Complete if Known**

Application Number	10/580,485
Filing Date	May 24, 2006
First Named Inventor	Joachim Moormann
Examiner Name	Jeffrey T. Palenik
Art Unit	1615
Attorney Docket No.	RO4246US (#90568)

**METHOD OF PAYMENT (check all that apply)**

☐ Check ☐ Credit Card ☐ Money Order ☒ None ☐ Other (please identify): \_\_\_\_\_

☒ Deposit Account Deposit Account Number: 08-2441 Deposit Account Name: D. Peter Hochberg Co., L.P.A.

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee

☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

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**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	310	155	510	255	210	105	
Design	210	105	100	50	130	65	
Plant	210	105	310	155	160	80	
Reissue	310	155	510	255	620	310	
Provisional	210	105	0	0	0	0	

**2. EXCESS CLAIM FEES**

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	210	105
Multiple dependent claims	370	185

**Total Claims**      **Extra Claims**      **Fee (\$)**      **Fee Paid (\$)**

\_\_\_\_\_ - 20 or HP = \_\_\_\_\_ x \_\_\_\_\_ = \_\_\_\_\_

HP = highest number of total claims paid for, if greater than 20.

**Indep. Claims**      **Extra Claims**      **Fee (\$)**      **Fee Paid (\$)**

\_\_\_\_\_ - 3 or HP = \_\_\_\_\_ x \_\_\_\_\_ = \_\_\_\_\_

HP = highest number of independent claims paid for, if greater than 3.

**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$260 (\$130 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
_____	_____	_____	130.00	0.00

**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): \_\_\_\_\_

**SUBMITTED BY**

Signature		Registration No. (Attorney/Agent)	24,603	Telephone	216-771-3800
Name (Print/Type)	D. Peter Hochberg	Date	July 21, 2008		

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Examiner Name	Jeffrey T. Palenik
Art Unit	1615
Attorney Docket No.	RO4246US (#90568)

**METHOD OF PAYMENT (check all that apply)**☐ Check ☐ Credit Card ☐ Money Order ☒ None ☐ Other (please identify): \_\_\_\_\_☒ Deposit Account Deposit Account Number: 08-2441 Deposit Account Name: D. Peter Hochberg Co., L.P.A.

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

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<b>Total Claims</b>		
Extra Claims	Fee (\$)	Fee Paid (\$)
- 20 or HP = _____ x _____ = _____		
HP = highest number of total claims paid for, if greater than 20.		
<b>Indep. Claims</b>		
Extra Claims	Fee (\$)	Fee Paid (\$)
- 3 or HP = _____ x _____ = _____		
HP = highest number of independent claims paid for, if greater than 3.		

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Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
_____ - 100 = _____	_____ / 50 = _____	(round up to a whole number) x	130.00	0.00

**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): \_\_\_\_\_

**SUBMITTED BY**

Signature		Registration No. (Attorney/Agent)	24,603	Telephone	216-771-3800
Name (Print/Type)	D. Peter Hochberg	Date	July 21, 2008		

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Date: 7/21/08

  
Sean Mellino

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant : Joachim Moormann, et al.  
Serial No. : 10/580,485 / Conf. No. 2532  
Filing Date : May 24, 2006  
Examiner / Group Art Unit : Jeffrey T. Palenik / 1615  
Title : ORAL FORMULATIONS OF DEOXYPEGANINE  
AND THEIR USES  
Attorney File : RO4246US (#90568)

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

**Reply to Office Action Issued July 2, 2008**

Dear Sir:

Claims 1-38 are pending in the instant application. The Examiner has concluded that restriction to one of the following two groups is necessary:

Group I - Claims 1-15 and 25-37, drawn to an oral dosage medicament containing deoxypeganine.

Group II – Claims 16-24 and 38, drawn to uses for cholinergic active substances.

The Examiner explains in the Office action that the inventions listed as Groups I

and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features since U.S. Patent No. 6,548,510 (Asmussen, et al.) teaches at column 2, lines 33-47, oral and transdermal pharmaceutical forms which controllably administer deoxypeganine or one of its pharmaceutically acceptable acid addition salts (e.g., hydrochloride or hydrobromide salt of deoxypeganine). The Examiner also states that the doses are further taught as comprising excipients, such as flow-improving agents, solvents, and oils, as well as comprising 0.7-50% by weight of free deoxypeganine.

The Applicants object to the instant restriction requirement, *with traverse*. It is respectfully submitted that the claims of Group I are directed to an orally administrable film-shaped medicament containing deoxypeganine and/or a deoxypeganine derivative. Claims 16 to 24 (Group II) pertain to the use of deoxypeganine or a deoxypeganine derivative for producing an oral, film-shaped medicament. Therefore, it is submitted that these two groups of claims pertain to the use of specific pharmaceutically active ingredients for manufacturing a specific medicament, namely, an orally administrable, film-shaped dosage form and to said medicament as such.

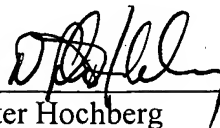
It is further submitted by the Applicants that, with respect to the “corresponding technical features in view of Asmussen, et al.,” the prior art reference only briefly mentions pharmaceutical dosage form for oral, transdermal or otherwise parenteral administration, and proposes that desoxypeganine can be present in such dosage forms in the form of a pharmaceutically acceptable acid addition salt. Asmussen, et al. fail to provide any indication that oral administration forms may be present in the form of a

film. Moreover, it is submitted that the oral administration form in Asmussen, et al. only pertains to conventional oral administration forms, such as tablets, capsules, lozenges, or liquids. Without any detailed disclosure pertaining to oral, film-shaped dosage forms, this characterization of the present invention appears to be sufficient to illustrate the single inventive concept the claims of both groups share. It is submitted that this is not contradicted by the fact that the claims directed to the medicament as such and the claims pertaining to the use of the active ingredient contain features being specific for each claim category and absent in the claims of the other category. Therefore, it is respectfully submitted that the claims of Group I and Group II are linked by the same technical features.

The Applicant hereby elects the claims of Group I (which consist of claims 1-15 and 25-37, drawn to an oral dosage medicament containing deoxypeganine) for further prosecution on the merits thereof.

The Examiner is invited to call the undersigned if there are any remaining issues to be discussed which could expedite the prosecution of the present application.

Respectfully submitted,

By:   
D. Peter Hochberg  
Reg. No. 24,603

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